



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

*BC2*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/814,409    03/11/97    KITAJIMA    H    826.1377/JPH

021171  
STAAS & HALSEY LLP  
700 11TH STREET, NW  
SUITE 500  
WASHINGTON DC 20001

WM31/0813

EXAMINER

MEISLAHN, D

ART UNIT

PAPER NUMBER

2132

DATE MAILED:

08/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 08/814,409	Applicant(s) KITAJIMA ET AL.	
	Examiner Douglas J Meislahn	Art Unit 2132	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-13, and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 15-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment filed 29 May 2001 that cancelled claims 5 and 14, amended claims 1, 6, 10, 15, and 19-25, and added claims 26-31.

### ***Response to Arguments***

2. Applicant's explanation of the use of the word "substantially" has clarified and estopped its meaning, thereby overcoming the rejection.
3. Applicant's arguments filed 29 May 2001 have been fully considered but they are not persuasive.
4. Applicant argues that the recitation of receiving change data from a remote computer via a communication network is not taught by either of the Dabbish references or any other references cited in the rejections. Figure 1 of Dabbish ('478) shows external programming equipment communicating via an input/output circuit. The EPE anticipates a remote computer, the I/O circuit reads on a network connecting unit, and the means over which the two communicate represents the network.
  1. from 1 through 23.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dabbish (4972478).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6, 8, 10-13, 15, 17, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish (4972478) in view of Knapp et al. (5499192) and the Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed.

In the abstract, Dabbish discloses a "... logic cryptographic circuit that can be reprogrammed with various cipher algorithms." Reprogramming implies changing means. Changeable deciphering apparatus is mentioned in column 3, lines 44-46. Part 103 on Dabbish's diagram is communication circuitry, meaning that the apparatus can be connected to a communication network. In lines 51-67 of column one, Dabbish states that orders to change the encryption algorithm originate from sources external to the apparatus. He does not say that the change unit bases its decisions upon a mapping data object. Knapp et al.'s abstract and first four columns teach mapping data to programmable logic devices, saying that it can achieve greater convenience. Knapp et al. do not say that a data object implements the mapping, but the computer dictionary teaches object-oriented programming as common. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use

the common object-oriented programming to map instructions, as taught by Knapp et al., to the reprogrammable circuit of Dabbish.

There is no mention in this of an enclosure substantially surrounding the electrical components. Official notice is taken that it is old and well known to shield electrical components from the environment by surrounding them within an enclosure. One example of this is the case in which computer components reside. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enclose the reprogrammable circuit, command unit, and changing means within protective material.

Claim 2's limitations are covered by Dabbish when the changes are considered in view of Knapp et al. Knapp et al. also teaches libraries and their associated elements in the paragraph spanning columns 3 and 4, thereby meeting claims 3, 4, and 6.

6. Claims 7 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish, Knapp et al. and the computer dictionary as applied to claims 1 and 10 above.

Dabbish presents a system in which ciphering algorithms are written to a circuit, thus changing the algorithm that the circuit follows. Dabbish does not say that the algorithms are updated on a periodic basis. Official notice is taken that updating keys or other cryptographic devices is old and well known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for periodic updates of the circuit, making it particularly useful in time specific applications such as pay television systems.

7. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish, Knapp et al. and the computer dictionary as applied to claims 1 and 10 above, and further in view of Lynn et al. (5345508).

Dabbish presents a system in which ciphering algorithms are written to a circuit, thus changing the algorithm that the circuit follows. The instructions to change the algorithm and the algorithm itself come from sources external to the circuit. Dabbish does not mention changing the circuits specifications based upon the communication path, degree of communication path security, or the process speed required. Lynn et al. talk about changing encryption keys based upon processing time and security. They specifically describe how their invention can be used to balance these factors in the first paragraph of the brief summary, line 54 of column 2 through line 36 of column 3. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for changes in the circuits specifications based upon the communication path, degree of communication path security, or process speed required. This would give flexibility to the system, letting it adapt to security and speed requirements.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached between 9 AM and 6 PM, from Monday through Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0040 for regular communications and (703) 308-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
DJM

August 7, 2001

Douglas J. Meislahn  
Examiner  
Art Unit 2132

  
GAIL HAYES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100